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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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| Proceeding | 78556095 |
| Applicant | Alternative Processing Systems, Inc. |
| Applied for Mark | AT STORE RECLAMATION |
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application of:

Alternative Processing Systems, Inc.

Serial No. 75/556,095

Filed: January 28, 2005

Mark: AT STORE RECLAMATION

TRADEMARK LAW OFFICE: 115

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APPELLANT’S REPLY BRIEF

Applicant respectfully re-urges that its mark is not *merely* descriptive and requests that the descriptive refusal be reversed.

DESCRIPTIVE REFUSAL

For all the reasons set forth in Applicant’s Appeal Brief, its mark should be registered because it is not *merely* descriptive because while it may suggest to the average prospective customer something about the features of Applicant’s services, it also will function as an indication of origin for those services. Additionally, the cases cited by the examiner to support its conclusion of “mere descriptiveness” are distinguishable here.

In the first case cited, *In re Aid Laboratories, Inc.*, 223 USPQ 357 (TTAB 1984), the TTAB took pains to explain the purpose for preventing registration of marks that are merely descriptive. First, it prevents the owner of a mark from inhibiting competition in the sale of

particular goods. Second, it maintains the freedom of the public to use the language involved, thus avoiding the possibility of harassing infringement suits by the registrant against others who use the mark when advertising or describing their own products. *In re Aid Laboratories, Inc.*, 223 USPQ at 5 (citing *Armour & Co. v. Organon Inc.*, 44 CCPA 1010, 1014 and 1016, 245 F.2d 495, 498 and 500, 114 USPQ 334, 337 and 338 (1957)). Thus, the test is "whether the subject is so close and direct that it is apparently descriptive and generally useful in approximately that form to all merchants marketing such goods, or is so remote and subtle that it is fanciful and not needed by other merchants of similar goods." *Id.*, 223 USPQ at 4.

In the foregoing case, the applicant sought to register "BUG MIST" for use with aerosol insecticides. The TTAB found that the mark was merely descriptive for two reasons. First, no imagination, thought or perception is needed to reach a conclusion as to the nature of the applicant's goods. Second, other manufacturers and merchants would have a competitive need to use the terms in applicant's mark to describe their own goods or services.

That is simply not the case here. Applicant's mark does *not* immediately convey an ingredient, quality, characteristic or feature of AT STORE RECLAMATION. Nothing in this mark indicates that Applicant's services pertain to reclamation of unsaleable grocery store products. It is impossible to discern from Applicant's mark what Applicant's services are. The average consumer, upon seeing or hearing the words AT STORE RECLAMATION is required to use a degree of imagination or reflection, to "mentally pause" in order to deduce a quality or characteristic of the goods. The consumer, in fact, needs additional information to understand that the Mark is referencing an inventory control system for grocery store products and the other services provided within a system for reclamation of grocery store products, including regular visits, scanning and processing, store reporting, transportation and donation, disposal, accounting

and reporting and customized coordination of collection of products. In contrast to BUG MIST, Applicant's competitors will not have a competitive need to use these terms in this combination in order to describe their goods or services. As neither of the factors used by the TTAB in reaching its conclusion in *In re Aid Laboratories, Inc.* is present here, this case is distinguishable.

The Examining Attorney also relies upon *In re Dial-a-Mattress Operating Corp.*, 240 F.3d 1341, 1346, 57 USPQ2d 1807 (Fed. Cir. 2001). In that case, the court found that the applicant's mark "1-888-MATRESS" was merely descriptive of the applicant's services, namely, "telephone shop-at-home retail services in the field of mattresses." The Examining Attorney relies on this case to support a conclusion that a mark need not describe the full scope and extent of the goods and services in order to be deemed merely descriptive. The mark at issue here is quite different, however. "AT STORE RECLAMATION" does not immediately describe grocery store services for reclaiming unsaleable goods in contrast to "1-888-MATRESS" which clearly conveys that calling the telephone number will avail customers of retail mattress sales.¹

Proposed Mark Not in Dictionary

The combination of two or more admittedly descriptive elements as a composite mark may result in a composite which is non-descriptive. *See e.g., Q-Tips, Inc. v. Johnson & Johnson*, 206 F.2d 144, 98 USPQ 86 (3d Cir. 1953). There is no overall definition of Applicant's mark "AT STORE RECLAMATION." While that fact may not in and of itself be dispositive, it is informative because the combination of these three terms does not immediately convey any specific meaning. Moreover, and as previously pointed out, the subject Mark could describe a variety of inventory control systems and does not describe the services relative to different types

¹ The final case cited in the Examining Attorney's first section is *In re Oppendahl & Larson, LLP*, 373 F3d 1171, 71 USPQ2d 1370 (Fed. Cir. 2004). This case relates to the issue whether adding ".com" or ".net" to an otherwise, and admittedly, descriptive mark will render the mark suggestive. Such analysis is not relevant to the issues herein.

of reclamation, different types of stores and different types of products. Given that there is no definition of the phrase as a whole and the variety of meanings the phrase could describe, the Mark is not merely descriptive.

Competitors' Use/Other Use of Reclamation

The Examining Attorney suggests that Applicant raised the issue of other use of "RECLAMATION" and/or submitted evidence in support of that issue for the first time in its Appeal Brief. This is blatantly untrue. Section C of Applicant's Office Action Response dated February 27, 2006 cites each of the uses raised in Applicant's Brief, with specific reference to the federal registrations and refers to the exhibits which were attached in support of that argument. To the extent that, due to some clerical error or otherwise, the hard-copy exhibits did not make it to the Examining Attorney, those issues were properly raised in a timely fashion and only referenced evidence that is already of public record and within the custody and control of the United States Patent & Trademark Office. Examining Attorney's objection to the admission of that evidence is insupportable and should be overruled.

As previously noted, the use of the term RECLAMATION in prior registrations is evidence of a determination by the Patent and Trademark Office that this term is *not* descriptive. Moreover, all of the cited subject registrations cover services which relate to Applicant's services. It further appears that all subject registrations have a disclaimer that no claim is made to the words of the marks except as shown in the mark. It is counter-intuitive that Applicant's use of the term RECLAMATION is the subject of an apparently more stringent and inconsistent standard of review. Applicant respectfully requests examination of the subject application in a manner consistent with earlier determinations made by the Patent and Trademark Office,

wherein at minimum a disclaimer may be filed such that no claim to AT STORE RECLAMATION is made apart from the mark as shown.

Using the example of other registered marks cited by Applicant, AT STORE RECLAMATION is at least as broad a term as ON SITE RECLAMATION or ENVIRONMENTAL RECLAMATION SERVICES. Because Applicant's Mark, like the above marks, is susceptible to a number of possible meanings, including a number of possible site-specific reclamation services unrelated to inventory control and reclamation of unsaleable grocery products, the mark is not merely descriptive, but also functions to identify the origin of the services. As the mark is *not* merely descriptive, it should be registered.

Applicant's Mark Evokes A Unique Commercial Impression

For all of the reasons previously stated and for all the foregoing reasons, the terms of Applicant's mark, when combined, merely suggest the types of services Applicant provides. Therefore, while each term of the mark may be descriptive, the composite creates a completely different commercial impression. Here, the mark as a whole is more than the mere sum of its parts. In other words, if Applicant's mark were "RECLAMATION SERVICES AT THE STORE" the Examining Attorney's arguments might have more weight. However, the arbitrary combination of the terms conveys a different connotation and, therefore, a unique commercial impression. *Cf. Aluminum Fabricating Co. v. Season-All Window Corp.*, 259 F.2d 314, 119 USPQ 61 (2d Cir. 1958) (mark "SEASON-ALL" found to be suggestive because the words are placed in an unusual order, where "ALL-SEASON" would have been merely descriptive).

Doubts Should Be Resolved In Applicant's Favor

Because the line between descriptive and suggestive marks can be nebulous, the Trademark Trial and Appeal Board has held that doubts about the merely descriptive nature of a

term arising under Section 2(e)(1) must be resolved in favor of the applicant. *In re Conductive Systems, Inc.*, 220 U.S.P.Q. 84 (TTAB 1983); *In re Gourmet Bakers, Inc.*, 173 U.S.P.Q. 565 (TTAB 1972) (THE LONG ONE held not descriptive of bread); *In re Morton-Norwich Products, Inc.*, 209 U.S.P.Q. 791 (TTAB 1981) (COLOR CARE not descriptive for laundry bleach); *In re Pennwalt Corp.*, 173 U.S.P.Q. 317 (TTAB 1972) (DRI-FOOT is not merely descriptive).

Applicant requests all such doubts to be resolved in its favor.

CONCLUSION

The Examining Attorney has not met the burden of making out a persuasive case for finding that Applicant's mark is *merely* descriptive. For all the foregoing reasons, and all the reasons previously stated in Applicant's Appeal Brief, the Examining Attorney has not carried the burden. Applicant's mark requires elements of imagination, thought and perception for a consumer to reach a conclusion as to the nature of Applicant's services, rendering it a suggestive, not a merely descriptive, mark. Applicant submits that its Mark is not merely descriptive and the Examiner's decision should be reversed and Applicant's application passed to publication.

Respectfully submitted,
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